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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/572,893	03/20/2006	Fufang Zha	2003P87075WOUS	2949

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SIEMENS CORPORATION
INTELLECTUAL PROPERTY DEPARTMENT
170 WOOD AVENUE SOUTH
ISELIN, NJ 08830

EXAMINER

MENON, KRISHNAN S

ART UNIT	PAPER NUMBER
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1797

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06/11/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/572,893	Applicant(s) ZHA ET AL.	
	Examiner Krishnan S. Menon	Art Unit 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-11,13-18 and 24-28 is/are pending in the application.
- 4a) Of the above claim(s) 13-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-11 and 24-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1, 4-11,13-18 and 24-28 are pending as amended in the RCE of 6/2/09, of which claims 13-18 are withdrawn from consideration.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 4-11 and 24-28 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the pending process claims of copending Application Numbers as shown below. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application claims the limitations claimed in these reference applications.

11/179,391: Claims 1-4,6,7,9-11,13-19

11/316,593: Claims 1-18,20-25,30

11/574,819: Claims 1-10

11/912,859: Claims 1-25

10/569,565: Claims 15-40

10/774,041: Claims 1-25.

10/572,971: Claims 1-11.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

1. Claims 1, 4-11 and 24-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Smith (US 5,403,479) and/or Sunaoka et al (5,209,852) and/or Kopp et al (US 5,643,455), and/or Cote et al (US 2001/0052494).and/or JP 11076769.

Smith teaches filtering using submerged membranes in a tank and backwashing the membrane as claimed under low pressure and pulsed flow with, among other options, permeate liquid – see column 11, lines 20-61 and the figures. Pressure applied is below the bubble point (line 30 at column 11). Smith in example (4) (fig. 4) shows permeate as the backwash fluid. Smith also teaches using a gas for the back flush – C12, L19-25, in which case there will be residual permeate in the hollow fiber lumen as well as the header and piping when the permeate side is switched (isolated: which requires operation of a valve; such steps are implied when Smith teaches using a gas to

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back-flush; also see fig 2, and its description in column 17, lines 7-56) to admit the gas, which would read on, or at least make obvious, the claims as amended. Smith also teaches that back-flushing using low pressure gas is well known in the art and discusses the pros and cons of this process – see C8, L18-30 and L39-47.

. Smith teaches cleaning hollow fiber membranes by back-pulsing with low pressure fluids in the lumen, wherein the cleaning agent can be a gas – see column 11, L 20 – C 12, L25. Specifically, Smith teaches using “no more than the bubble point”. Smith also teaches bubbling air on the external surface of the membrane (fig 2, C17, L7-31). Isolating the membrane from the filtrate collection area is implied when the reference teaches introducing a gas or cleaning chemical into the lumen.

Sunaoka teaches in column 1, under “Prior Art” (line 14), scouring the membrane (scrubbing) with gas bubbles, backwash before, during or after scouring, and drain down. Sunaoka teaches draining by charging compressed air - see column 6, lines 63-68. Sunaoka teaches in column 8, line 63 - column 9, line 21, blow down of the wastewater from the tank using water head or compressed air, as well as secondary washing after the blow-down. Sunaoka also teaches using compressed air to effect backwash – see column 10, lines 58-64. Also, using compressed air to effect pumping of liquids, and particularly, for backwashing filters and membranes is well known in the art.

Kopp teaches using air in the lumen of the hollow fibers at below the bubble point to flush water from the lumen and then above the bubble point to have effective air back-flush, while agitating the membrane. Kopp, C3, L27 – C4, L50. Scouring with

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external gas – see C4, L10-13. Kopp also contemplates the various steps recited in the dependant claims, such as reducing the volume of the liquid suspension, etc. Kopp also teaches delaying the onset of filtration process until the expanded membrane is relaxed to its normal condition after the back wash with air bubbles through the lumen (to prevent quicker plugging of the expanded fiber pores as they relax), which suggests using Smith's teaching to modify Kopp, so that the backwashing is done only at a pressure as taught by Smith. Agitation of the membrane by scouring gas is taught by Cote, and is well known in the art.

Cote teaches back-washing and back-pulsing the membrane while scouring the membrane externally with air bubbles, which is conducted before or during draining the tank – see under the heading: "Chemical Cleaning with Tank Drained or Draining". The chemical cleaning agent can be a gas. Scouring the membrane with gas bubbles to keep the surface clean as well as agitate the fluid is also well known in the art, and is not an inventive process step.

JP-11076769 also teaches backwashing wherein the gas pressure is below the bubble point – see JP translation provided herewith, in an 892.

KSR Int'l. v. Teleflex Inc., 127 S. Ct. 1727, 1732, 82 USPQ2d 1385, 1390 (2007): "it is commonsense that familiar items have obvious uses beyond their primary purposes, and a person of ordinary skill often will be able to fit the teachings of multiple patents together like pieces of a puzzle". "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results".

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It would be obvious to one of ordinary skill in the art to combine the teachings of these references to arrive at the process recited in the claims because it would be obvious to use known process steps such as using compressed air to effect fluid flow to backwash the membrane, the backwash pressure being sufficient to make the liquid flow as taught by Smith, Sunaoka and/or Kopp in the process of filtering, scouring the membrane and draining as taught by Sunaoka or Cote; results of such steps being only predictable. For example, one would use the teachings of Smith for the backwashing steps in the teaching of Sunaoka because it is highly effective according to Smith (column 11, lines 1-3), and one would use the teaching of Sunaoka in the teaching of Smith to drain the tank and get rid of the accumulated waste especially in batch and semi-continuous operations.

Regarding the "inside-out" filtration as in claim 10, it is well known that hollow fibers can be used for both "outside-in" and "inside-out" operation, as is evidenced by **Bartels et al** (US 2003/0150807): paragraph 0039; or Smith C1, L18-23. Therefore, having the process recited for an "inside-out" filtration membrane would be obvious, compared to the "outside-in".

Additional details of the structure of the membrane system are well known in the art, and the references do teach such details. Suspending filtration and isolating the lumen of the hollow fiber and the header/manifold are implied if not explicit in the references, since providing a gas through the lumen of the hollow fibers for back flush require that the lumen and the manifold is fluidly connected to such gas source.

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Applying back flush requires stopping the filtration process, which is not inventive as argued.

The additional step of venting the gases remaining in the lumen is also implied, since such gas remaining in the lumen will be vented out through the filtrate flow when normal filtration is resumed. This is also not an inventive process step.

Response to Arguments

Applicant's arguments filed 6/2/09 have been fully considered but they are not persuasive. Arguments only discuss what is not taught in the references individually, and do not really address the prima facie case. Arguments are generally addressed in the rejection. Additional limitations in the claims do not add any inventive process steps to the claims, but simply recite the structure required to make the process steps of the prior versions of the claims possible.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krishnan S. Menon whose telephone number is 571-272-1143. The examiner can normally be reached on 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vickie Kim can be reached on 571-272-0579. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Krishnan S Menon/
Primary Examiner, Art Unit 1797